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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,116	03/04/2008	Jacob Guth	034547-0118	2271
22428 7590 11/08/2010 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER GREENE, IVAN A				
ART UNIT		PAPER NUMBER		
1619				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/596,116

Applicant(s)

GUTH ET AL.

Examiner

IVAN GREENE

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the claims

Claims 1-8 are currently pending and are presented for examination on the merits. The examiner notes that applicant's response papers filed 08/24/2010, include the following heading information which is believed by the examiner to be a clerical error:

Attorney Docket No. 034547-0118 U.S. Application No. 10/987,454
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The instant application is application No. 10/596,116, and the attorney docket number on file for the instant application is 034547-0118. However, applicant's arguments are directed toward the instant application. Accordingly the instant office action is in response to the submitted arguments.

Priority

The U.S. effective filing date has been determined to be 04/05/2004, the filing date of the document PCT/EP05/03501. The foreign priority date has been determined to be EPO 04016057.4, the filing date of document 07/08/2004.

Advisory Notice

All rejections and/or objections not explicitly maintained in the instant office action have been withdrawn per Applicants' claim amendments and/or persuasive arguments.

Claim Rejections - 35 U.S.C. 112, 1st Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

New grounds of rejection necessitated by amendment: Claims 1-8 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a New Matter Rejection.

Applicant has amended claim 1 to incorporate the new matter “intact” vegetable oil bodies. Applicant has not pointed to any portion of the instant specification for support of this amendment and the examiner is unable to find support for this amendment in the specification or the claims as originally filed. Accordingly the amendment is rejected as new matter.

Applicant is required to cancel the new matter in any response to this office action or such a response will be held as non-compliant.

Claim Rejections - 35 U.S.C. 112, 2nd Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7, which depends from claim 1, recites "no additional emulsifier is used", however claim 1 does not expressly include an emulsifier. Furthermore, the instant specification does not provide guidance as to what exactly is considered an "emulsifier". It is unclear what the metes and bounds of the recited "emulsifier" should be. Appropriate clarification is required.

Claim Rejections - 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

New grounds of rejection necessitated by amendment: Claims 1-4 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by LORANT (US 6,465,402).

Response to Arguments:

Applicant's arguments filed 08/24/2010 have been fully considered but they are not persuasive.

Applicant's argument that Lorant's composition does not necessarily comprise intact oil bodies (arguments p. 5, lines 8-9), is not convincing because applicant has provided no evidence on the record to support this position. Applicant further states that "oil bodies refer to discrete structure[s] within the seeds of oilseed crops". And example relied upon by the examiner

includes apricot oil an "oilseed crop" which would have inherently contained intact oil vegetable bodies. Thus, absent evidence to the contrary the example of LORANT includes intact vegetable oil bodies. Applicant is reminded that the U.S. Patent Office is not equipped with analytical instruments to test prior art compositions for the infinite number of ways that an applicant may present previously unmeasured characteristics. When as here, the prior art appears to contain the exact same ingredients (i.e. the oilseed crop apricot oil) and applicant's own disclosure supports the suitability of the prior art composition as the inventive composition component, the burden is properly shifted to applicant to show otherwise.

Applicant's argument that the assignee SemBioSys Genetics, Inc. specializes in technology devoted to maintaining intact oil bodies and preparations for isolating and using the same, is acknowledge. In response the examiner argues that the instantly claimed invention is not reasonably limited by the specific technology of the assignee SemBioSys Genetics, Inc. The claims do not require such technology and/or methodology. In fact vegetable oil bodies, as currently claimed, are an integral part of plant tissues as evidenced by KLEINIG (see p. 233, col. 1, line 1):

Oleosomes¹, the triacylglycerol containing cell inclusions, are present in all plant tissues. They are, however, especially abundant in the cells of oil-rich seeds.

Accordingly, oil extracted from oil-rich seeds (e.g. apricot oil) would have included oleosomes.

Applicant's argument that it is generally accepted that lotions and creams differ based on their water content is unsupported by any evidence. And it is the examiner's position that using the "broadest reasonable interpretation", a lotion is synonymous with cream a cream.

New grounds of rejection necessitated by amendment: Claims 1, 5 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by MARKETMAN (retrieved from: www.marketmanila.com/archives/fresh-buko-coconut-juice; published on the internet January, 2005); as evidenced by KLEINIG (Planta, 1978, Vol. 140, pp. 233-237).

MARKETMAN discloses fresh coconut juice extracted from young coconuts in which the meat is still thin, opaque, soft and easily scrapped from the inside of the fruit (p. 1, last paragraph).

KLEINIG discloses (see p. 233, col. 1, line 1):

Oleosomes¹, the triacylglycerol containing cell inclusions, are present in all plant tissues. They are, however, especially abundant in the cells of oil-rich seeds.

Accordingly, the coconut juice with the fresh scrapped meat would have been an oil-in-water emulsion comprising at least 60 wt. % water and intact coconut oil bodies. The preparation clearly involves breaking the coconut and pouring (i.e. mixing) the juice into a glass, and scraping the meat from the inside and adding to the coconut water. The preparation does not involve any heating, and the composition does not include any additional emulsifier. Additionally the coconut juice would have contained a dermatologically active agent such as vitamin C.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

New grounds of rejection necessitated by amendment: Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over LORANT (US 6,465,402) in view of KAURANEN (WO 2004/082642; published September, 2004).

**Determination of the scope
and content of the prior art (MPEP 2141.01)**

LORANT discloses an oil-in-water emulsion cream as follows (col. 12):

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Example 2

Care Cream

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Aqueous phase:

Sepigel 305 (sold by the company Seppic)	2%
Preservatives	0.4%
Glycerol	3%
Demineralized water	q.s. for 100%

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Oily phase:

Volatile silicone oil (cyclohexasiloxane)	7%
Apricot oil	5%
KSG 21 (containing 28% of active material) (i.e. 1.4% of active material)	5%

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Procedure: The aqueous phase is prepared by dispersing, with stirring, the Sepigel 305 in the water containing the preservatives and the glycerol. The KSG 21 is then dispersed in the liquid oily phase and emulsification is subsequently carried out by dispersing, with vigorous stirring, the mixture obtained in the aqueous phase.

A slightly translucent cream is obtained which is very soft and fresh on the skin.

The above example comprises the vegetable oil, apricot oil, and 77.6% water.

Furthermore, the limitation --washed vegetable oil bodies-- is considered a product-by-process limitation. And the patentability of a product does not depend on its method of production. If the product in the product-by-process limitation is the same as from a product of the prior art, the claim is unpatentable even though the prior product was made by a different

process.” See MPEP § 2113.

Regarding the limitation that processing temperature does not exceed about 40°C, the process described by LORANT includes only stirring the ingredients together and does not disclose any heating step. And because ambient room temperature would have been expected to be less than 40°C the limitation is met.

LORANT teaches the oily phase is preferably from 7 to 30 wt. % of the composition (10:20-25). Accordingly, the limitation requiring an aqueous phase of 70-75 wt. % is met (see MPEP §2144.05 which discussed the obviousness of ranges).

The difference between the instantly rejected claims and the teachings of LORANT is that LORANT does not expressly teach the inclusion of safflower oil. This deficiency in safflower oil is cured by the teachings of KAURANEN.

KAURANEN teaches skin care products containing vegetable oils, such as safflower oil (p. 6, line 27, discloses "safflor oil" which is clearly intended to be safflower oil). KAURANEN further teaches the trend in the skin care products industry is toward natural ingredients including "cold-pressed" seed oils. It is the examiner's position that such a cold pressed seed oil would have contained intact vegetable oil bodies.

Finding of *prima facie* obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made to include the safflower oil taught by KAURANEN in the cosmetic emulsion of LORANT and produce the instantly claimed invention because, as suggested by

KAURANEN, the safflower oil would have been suitable for a cosmetics emulsion. The selection of a known material base upon its suitability for its intended use supported a *prima facie* case of obviousness determination in *Sinclair and Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (see MPEP § 2144.07). It would have been *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made to include cold-pressed safflower oil because of the industry trend toward natural products. One of ordinary skill in the art would have been motivated to include cold-pressed safflower oil because the natural cold-pressed oil would have greater consumer appeal thus providing a more valuable product.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention because cold-pressed oils are known in the art and suitably useful in a natural cosmetic product. Such use would simply involve substituting the cold-pressed oil in the process of LORANT. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

Conclusion

Claims 1-8 are pending and have been presented for examination on the merits. Claims 5-8 have been objected to and not further treated on the merits; and claims 1-4, 5 and 7 are rejected

under 35 U.S.C. 102(b); and claims 6 and 8 are rejected under 35 U.S.C. 103(a) No claims allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IVAN GREENE whose telephone number is (571)270-5868. The examiner can normally be reached on Monday through Thursday 7AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bonnie Eyster can be reached on (571) 272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IVAN GREENE
Examiner, Art Unit 1619

/Cherie M. Woodward/
Primary Examiner, Art Unit 1647